

REMARKS

Claims 75-82 remain in the application for further prosecution. Claims 77 and 78 have been amended. Claim 83 has been added.

Claim Rejections – 35 U.S.C. § 103

Claims 75-82 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Raven et al. (U.S. Patent No. 5,429,361) in view of Sizer et al. (U.S. Patent No. 5,923,252). Applicant respectfully traverses these rejections.

The problem Raven attempts to solve is, according to Raven's Background section, that "[i]n the past it has not been possible for a player to interrupt his play, leave the machine briefly, and then return and resume play." Col. 1, ll. 34-36. Raven discloses a personality card that is physically inserted into a gaming machine. Col. 4, ll. 62-66. Data from the card is then communicated between gaming machines and a central control system and between a player or operator and a central control system. *Id.*, abstract; col. 1, ll. 7-33. Upon physically inserting his card into the gaming machine, the player can reserve a game or resume a previously interrupted game. The gaming machine does not even know the player is at the machine until the player inserts his card and the gaming machine verifies and reads it. Col. 7, ll. 51-53.

Sizer, entitled "Audio/Visual Marketing Device and Marketing Device and Marketing System," relates to a device for delivering audio messages for marketing purposes. Sizer, abstract; col. 1, ll. 6-10. Sizer does not mention gaming machines, nor suggests anywhere that its message delivery device can be used in connection with gaming machines. The message delivery device is installed in a retail store near products that are to be marketed to a shopper. The message delivery device detects the presence of the shopper and broadcasts through speakers a message designed to encourage the shopper to purchase the product, such as wine, or a cross-promoted product. *Id.*, col. 2, ll. 29-43. The shopper does not interact with the message delivery device nor is invited to interact with it, and the message delivery device has no inputs (other than the sensor 2) with which the shopper can interact.

Applicant respectfully submits that claims 75-82 are not obvious over Raven in view of Sizer because a *prima facie* case of obviousness has not been made. The Raven-Sizer combination fails due to a lack of motivation, suggestion, or incentive to combine these references. In order to establish a *prima facie* case of obviousness, there must be some suggestion in the references or in the knowledge generally available to one of ordinary skill in the art for making the combination. *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). “There must be a teaching or suggestion within the prior art, or within the general knowledge of a person of ordinary skill in the field of the invention, to look to particular sources of information, to select particular elements, and to combine them in the way they were combined by the inventor.” *ATD Corp. v. Lydall, Inc.*, 48 U.S.P.Q.2d 1321, 1329 (Fed. Cir. 1998).

Applicant submits that there is no suggestion, teaching, or motivation in either Raven or Sizer to make the proposed combination. *See In re Fine*, 837 F.2d at 1074, 5 U.S.P.Q.2d at 1599. It would not have been obvious to one of ordinary skill in the art to modify the gaming machine disclosed in Raven with the audio/visual marketing device of Sizer to arrive at Applicant’s claimed invention. In the Background section of Applicant’s disclosure, numerous problems and drawbacks associated with manually inserted portable data units in gaming environments are described beginning on page 2, line 21:

Heretofore, to communicate with gaming machines, portable data units of the above type have had to be manually inserted by players into data unit readers at the gaming machines. This arrangement suffers from numerous drawbacks. First, the process of retrieving the portable data unit and manually inserting it into a data unit reader can be inconvenient to a player especially if the player wishes to play numerous gaming machines in a relatively short period of time. Second, unless the portable data unit is somehow attached to the player by a string, chain, or the like, a player may forget to remove the portable data unit from the data unit reader upon completion of a gaming session, thereby possibly allowing a subsequent unscrupulous player at that gaming machine to use the data unit for his/her own benefit. Third, data unit readers are often disposed at peculiar locations on gaming machines, such as above a video or mechanical display. This, in turn, requires a player to awkwardly reach for the peculiar location to manually insert the portable data unit. If the portable data unit is attached to a string or the like, it is common for the string to hang over and partially obscure the machine display as the player plays the gaming machine.

The system described in Raven suffers from precisely the drawbacks that Applicants' invention sought to overcome. For example, Raven discloses a manual card reader 12 that accepts a card carried by the player. However, the player must first locate the card reader 12 on the gaming machine, retrieve the card from the player's person, and then insert the card into the card reader 12. This time-consuming process causes the player to spend time fiddling around with his card and the card reader instead of playing the game and contributing to a profitable gaming environment for the gaming establishment. In Figure 1 of Raven, a manual card reader is located at a peculiar location above and to the right of the primary display. When the player inserts a card into the card reader 12, the card must be kept in the card reader 12 until the player is ready to leave the machine. *See, e.g.,* Col. 8, ll. 29-30. A player could easily forget his card is still in the card reader 12 after several minutes of play, which suffers from the security and convenience drawbacks as mentioned in Applicants' disclosure. Nowhere does Raven mention or even suggest that the card reader 12 can be modified to be wireless. Because Raven's disclosure suffers from the drawbacks described in Applicants' disclosure, Raven actually teaches away from the claimed invention. The only suggestion to modify Raven is found in Applicant's disclosure, and to reject the claims on that basis would be impermissibly using hindsight reconstruction.

Accordingly, Applicants submit that it would not have been obvious to modify Raven to include the wireless features of Sizer. If a rejection is maintained based on a modification of Raven in view of Sizer, Applicants respectfully request that the subsequent Office Action identify where, either in the references or knowledge generally available to one of ordinary skill in the art, such modification is suggested.

In addition, to modify Raven to add the feature of detecting the presence of a passerby proximate to the gaming machine, the passerby not playing the gaming machine and modifying the operation of the gaming machine in response to detecting the presence of the passerby would require substantial reconstruction and redesign of both hardware and software and would change the basic principle (wired to wireless communication) under which Raven was designed to operate.

Regarding Sizer, the Office Action asserts that "Sizer's system is directed at the attracting a passerby to **interact with** point-of-sale devices and storing information tracking their interaction."

Office Action, at 3. What “point-of-sale devices” does Sizer disclose with which a customer can interact? Sizer discloses no such devices. Sizer’s message delivery device is a “passive” device in the sense that the passing shopper does not interact with the device. Sizer’s message delivery device simply broadcasts an audio message through its speakers to the shopper. Sizer provides examples of the products marketed by the message delivery device, which cannot be interacted with. These products include a “particular brand of wine” (*id.*, col. 2, ll. 39-51; col. 4, ll. 1-12), “products available for purchase within the petrol station” (*id.*, col. 5, ll. 18-19), “a particular exhibit” at a museum or art gallery (*id.*, col. 5, ll. 26), “a safety message” warning a person standing on the edge of a train platform (*id.*, col. 5, ll. 27-30), or at a pedestrian intersection or in loiter-free places (col. 5, ll. 30-34). Nowhere does Sizer suggest that the passerby can interact in any manner with the message delivery device let alone play it. Thus, claims 79, 82, and 83 are patentably distinct over Raven in view of Sizer.

The Office Action asserts that “[a] casino is merely a specialized type of commercial establishment where the point of sale devices are gaming machines.” To the extent that this statement seeks to analogize a gaming machine with the message delivery device of Sizer, Applicant respectfully submits that the analogy fails because the message delivery device of Sizer is not the product being marketed to the consumer. The wine bottles or convenience store items are the products with which the shopper is encouraged to purchase by Sizer’s message delivery device. The shopper is not encouraged to play, or place a wager, or otherwise interact in any fashion on the message delivery device itself. By contrast, a gaming machine is the “product” that a player is encouraged to interact with by inputting a wager. In this respect, Sizer is non-analogous because it is directed to a device that broadcasts marketing messages to passing customers to encourage them to purchase products near the device not the device itself. Gaming machines do not promote or market the products of the types suggested by Sizer; rather, they offer a form of entertainment and opportunities to win money or prizes, which require direct player interaction with the gaming machine itself. For at least the foregoing reasons, claims 75-82 are believed to be patentable over Raven in view of Sizer.

Applicant further submits that the Raven-Sizer combination has been made based on improper hindsight reconstruction. An obviousness determination is improper when it is “based on

the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention.” *ATD Corp. v. Lydall, Inc.*, 48 U.S.P.Q.2d 1321, 1329 (Fed. Cir. 1998). It is impermissible to “use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.” *In re Fritch*, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992), quoting *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

Here, Applicant respectfully submits that the Raven-Sizer combination is being impermissibly made only in light of the knowledge of Applicant’s disclosure. But for the knowledge of Applicant’s claimed method of operating a gaming machine by detecting the presence of a passerby and correspondingly modifying the operation of the game, the Raven-Sizer combination would not have occurred to one of ordinary skill in the art.

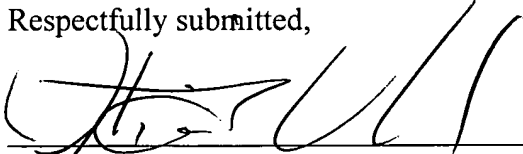
For at least the foregoing reasons, Applicant respectfully submits that the present independent claims 75 and 83 are patentable in view of Raven over Sizer and are in condition for allowance. The remaining claims 76-82, which depend either directly or indirectly from independent claim 75, are also allowable for at least the same reasons.

Conclusion

A fee for a petition for a two-month extension of time is enclosed herewith. It is believed that no additional fee is presently due; however, should any additional fees be required (except for payment of the issue fee), the Commissioner is authorized to deduct the fees from Jenkins & Gilchrist, P.C. Deposit Account No. 10-0447, Order No. 47079-00107USD2.

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Respectfully submitted,



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